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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/800,909

03/15/2004

William Sears

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EXAMINER

SCHILLINGER, ANN M

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/800,909	Applicant(s) SEARS ET AL.	
	Examiner ANN SCHILLINGER	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-25 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 12, 15, 16, 21, 22, 24, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferree (US Pub. No. 2004/0093082). Ferree discloses the following of the claimed invention, as shown in Figures 4A-4D: a first plate (top element 102) including a concave articulation surface (left indented portion) and a first recessed surface (center indented portion); a second plate (lower element 102) having a second recessed surface (center indented portion); a convex articulation member (106); and a plurality of motion controlling members (104). Please see paragraphs 0059 and 0061.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferree in view of Berry (U.S. Pat. No. 5,895,428). Ferree discloses the invention substantially as claimed, however it does not disclose using an amorphous oxide coating on the implant's plates. Berry teaches using an amorphous oxide coating on a spinal implant's plates. Berry teaches this in col.

10, lines 38-42 and 56-57 for the purpose of decreasing the frictional wear on the implant over time. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use this type of coating to prevent the implant from being damaged by friction.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferree in view of Buttner-Janz et al. (U.S. Pat. No. 5,401,269). Ferree discloses the invention substantially as claimed, however Ferree does not disclose having a projection on the articulation member. Buttner-Janz et al. teaches a vertebral body prosthesis with a projection in col. 3, line 63 through col. 4, line 37 for the purpose of controlling the movement of the articulation member. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a projection on the articulation member in order to control the articulation member's movement.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferree in view of Xavier et al. (U.S. Pat. No. 6063121). Ferree discloses the invention substantially as claimed, however Ferree does not disclose using a cord with the motion-controlling member. Xavier et al. teaches a vertebral body prosthesis using a cord with the motion-controlling member in col. 4, lines 21-43 for the purpose of reinforcing the motion-controlling member's structure. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cord with the motion-controlling member in order to reinforce the motion-controlling member's structure.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferree in view of Michelson (U.S. Pat. No. 6,350,283). Ferree discloses the invention substantially as claimed,

however Ferree does not disclose using a bio-resorbable material on the elastic members.

Michelson teaches a spinal implant using a bio-resorbable material on the elastic members in col. 2, lines 47-67 for the purpose of allowing those implant parts to be biologically replaced in the body over time. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use a bio-resorbable material on the elastic members in order to allow those implant parts to be biologically replaced in the body over time.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferree in view of Rabbe et al. (U.S. Pat. No. 5776197). Ferree discloses the invention substantially as claimed, however Ferree does not disclose having hollow portions in the implant. Rabbe et al. teaches a vertebral prosthesis using hollow portions in col. 3, lines 40-50 for the purpose of allowing bone ingrowth. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to include hollow portions in order to allow bone ingrowth.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferree in view of Ray et al. (U.S. Pat. No. 4,772,287). Ferree discloses the invention substantially as claimed, however, Ferree does not disclose using gel in the elastic members. Ray et al. teaches a spinal disc implant using gel in the elastic members in col. 3, lines 8-17 because gel has inherent properties that mimic the natural movement of intradiscal nuclear tissue. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use gel in the elastic members of the implant because their viscosity and velocity-shear behavior matches that of the intradiscal nuclear tissue.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferree in view of Bryan et al. (U.S. Pat. No. 6,156,067). Ferree discloses the invention substantially as

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claimed, however, Ferree does not disclose the elastic members have a sphere or wheel shape. Bryan et al. teaches a spinal prosthesis with sphere and wheel shaped elastic members in col. 3, line 62 through col. 4, line 57 for the purpose of allowing the prosthesis to have a greater range of movement. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use wheel or sphere shaped elastic members in order to give the prosthesis a greater range of motion.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferree in view of Hochshuler et al. (U.S. Pat. No. 6,576,016). Ferree discloses the invention substantially as claimed, however, Ferree does not disclose arranging the plurality of recesses in a circular dove-tail shape. Hochshuler et al. teaches a spinal prosthesis that arranges the plurality of recesses in a circular dove-tail shape in col. 2, lines 15-67 for the purpose of conforming to the shape of the plates and the vertebrae. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to arrange the plurality of recesses in a circular dove-tail shape in order to conform to the shape of the plates and the vertebrae.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferree in view of Casutt. (U.S. Pub. No. 2003/0045939). Ferree discloses the invention substantially as claimed, however Ferree does not disclose using an attachment mechanism on the elastic members. Casutt teaches a vertebral body prosthesis using an attachment mechanism on the elastic members in paragraphs 0035-0036 for the purpose of securing the elastic members to the rest of the prosthesis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an attachment mechanism in order to secure the elastic members to the rest of the prosthesis.

Response to Arguments

Applicant's arguments with respect to claims 1-10, 12-25, and 27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann Schillinger/
Examiner, Art Unit 3774

/DAVID J ISABELLA/
Supervisory Patent Examiner, Art Unit 3774